PATENT
Customer No. 22,852
Attorney Docket No. 2418.0128-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	
Herfried LAMMER	Group Art Unit: 3711
Application No.: 09/918,437	Examiner: R. Chiu
Filed: August 1, 2001	
For: RACKET WITH SELF-POWERED PIEZOELECTRIC DAMPING SYSTEM (As Amended)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF

Pursuant to 37 C.F.R. §1.193, Appellant submits this Reply Brief to the Examiner's Answer mailed October 1, 2003.

Remarks

In addition to the arguments for reversal of the Examiner's rejection provided in Applicant's Appeal Brief filed on July 21, 2003, Applicant provides the following remarks regarding the Examiner's Answer mailed on October 1, 2003. In the rejection of claims 1-14 of the application, the Examiner states that U.S. Patent No. 5,857,694 to Lazarus et al. ("Lazarus") discloses circuitry located within a racquet. See page 4, last paragraph, of the Examiner's Answer. This statement is incorrect. Figs. 10 and 10a of Lazarus disclose electroactive actuators located within the frame of a racquet, but do

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not disclose circuitry connected to the actuators. See col. 14, lines 13-19 of Lazarus. This deficiency highlights the tenuous obviousness conclusions provided in the outstanding rejection.

Additionally, Applicant submits that the Examiner's unsupported conclusions that "it would have been an obvious matter of design choice to place [circuitry] in the end cap of the racquet handle," and that "the shape of the actual space [in which the circuit is affixed] is not considered to be critical" are improper. See page 5, lines 1-7, of the Examiner's Answer. The examiner is required to provide support for such determinations, be it in the form of case law or by taking official notice of the knowledge of one of ordinary skill in the art. See M.P.E.P. Sections 2144.03 and 2144.04. The Examiner's failure to provide such support for the expressed conclusions provides the Applicant little recourse in traversing these aspects of the rejection. In addition, the need for the Examiner to rely on such unsupported conclusions clarifies the fact that, even if it were appropriate to combine all three prior art references as asserted by the Examiner, the combination would not, without more, render obvious the claimed invention.

Finally, regarding the claimed laminated attachment of the at least one transducer element to the racket frame (independent claims 1 and 6), the Examiner refers to U.S. Patent No. 5,869,189 to Hagood for disclosing this aspect. See page 3, first paragraph, of the final Office Action dated October 21, 2002 (paper no. 10). The Examiner, however, provides no motivation to combine this aspect of Hagood to the racquet disclosed in Lazarus. A proper rejection under 35 U.S.C. § 103(a) requires the Examiner to provide some suggestion or motivation to modify the reference or combine

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reference teachings. Accordingly, the outstanding rejection is deficient and should be reversed.

In view of the aforementioned reasons and those reasons provided in Applicant's Appeal Brief, Appellant respectfully submits that the rejections of claims 1-14 are in error and should be reversed.

To the extent any fees are required to enter this Appeal Brief, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: December 1, 2003

By: _____
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